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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,164	02/14/2002	Shinya Adachi	NGB-34408	6919
116 7590 11/14/2008 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			EXAMINER KENNEDY, ADRIAN L	
			ART UNIT	PAPER NUMBER
			2129	
			MAIL DATE	DELIVERY MODE
			11/14/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/075,164

**Applicant(s)**

ADACHI ET AL.

**Examiner**

ADRIAN L. KENNEDY

**Art Unit**

2129

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 6, 12, 13 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 12, 13 and 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Examiner's Detailed Office Action***

1. This Office Action is responsive to **Amendment After Non-Final** filed **August 12, 2008**.

2. **Claims 1, 6, 12-13, 16-21** will be examined.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner has found no support in the applicant's disclosure for the claimed first digital map having a different error from a second digital map.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1, 6, 12-13, 16-21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the claimed invention is rejected due to the fact that it is (1) not tied to another statutory class (such as a particular apparatus), nor does it (2) transform underlying subject matter to a different state or thing.

The claims must to provide a tangible result, and there must be a practical application, by either

- 1) transforming (physical thing) or
- 2) by having the FINAL RESULT (not the steps) achieve or produce  
a useful (specific, substantial, AND credible),  
concrete (substantially repeatable/non-unpredictable), AND  
tangible (real world/non-abstract) result.

A claim that is so broad that it reads on both statutory and non-statutory subject matter, must be amended. A claim that recites a computer that solely calculates a mathematical formula is not statutory.

However, the portions of the opinions in State Street and AT&T relying solely on a “useful, concrete and tangible” result analysis should no longer be relied on. Ex parte Bilski, Appeal No. 2007-1130 (Fed. Cir. October 30, 2008).

The court has said that there's a two-pronged test to determine whether a software of business method process patent is valid: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. In other words, pure software or business method patents that are neither tied to a specific machine nor change something into a different state are not patentable. Ex parte Bilski, Appeal No. 2007-1130 (Fed. Cir. October 30, 2008).

The body of the claims needs to be tied to a statutory class. For example, how are “events” created? What means is used to perform these functions?

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12, 13, 17 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over **Ito et al.** (USPN 6,249,740, referred to as **Ito**) and **Myr** (USPubN 2001/0029425, referred to as **Myr**), in view of **Schipper** (USPN 5,815,118, referred to as **Schipper**).

Regarding claim 12:

Ito teaches

a digital map (Ito: C 3, L 65-67);

an information generator that generates, based on the digital map, location information (Ito: C 3, L 65-67) including:

a list of points on a road segment of the digital map, and attribute information on said points (EN: The examiner takes the position that the above claimed information including a “list of points on a road segment” are all anticipated by navigation data as taught in Column 3, Lines 65-67 of the invention of Ito et al.); and

a transmitter that transmits the location information (Ito: C 3, L 14-28) to a receiving apparatus (Ito: C 3, L 29-34) having another digital map including data representing the road segment, said data being different from the list of points (Ito: C 9, L 38-42; EN: Having not defined the term “different” in the claimed invention, and having not claimed what the applicant means by claiming that the “list of points” is “different” from the “data”, the examiner has asserted a definition of these terms and phrases. Based on this assertion, the examiner has found that Ito et al. anticipates the applicant’s claim “list of points” being

"different". This assertion is based on the fact that it would have been obvious to one of ordinary skill in the art that the data transmitted from one location is "different" from the data at a second location.).

Ito does not teach the use of event location information or point at the periphery of an event.

However, Myr does teach

The mapping of event location information (Myr: ¶ 0178; EN: Having not further defined the applicant's claimed "event location information" in the claimed invention, the examiner has found that the applicant's claimed "event location information" reads on the traffic accident (i.e. the "event") location information as taught by Myr.

Neither Ito nor Myr teach points being at the periphery of an event.

However, Schipper does teach

Points being at the periphery of an event (Schipper: C 5, L 10-20; EN: The examiner asserts that the applicant's claimed periphery of an event, is actually the periphery of an event location. Furthermore, based on this assertion, the examiner takes the position that the claimed points at the periphery of an event (location) are obvious in light of the use of landmarks and monuments (i.e. "points") at the periphery of a user's location (i.e. "event location") as taught by Schipper.).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the vehicle guidance system of Myr and the vehicle navigation apparatus of Ito with the location determination method taught by Schipper for the purpose of mapping user locations using inconsistent location information (Schipper: C 5, L 10-20).

Regarding claim 13:

Ito teaches,

a receiver that receives location information (Ito: C 3, L 29-34) including:

a list of points on a road segment of a digital map, the attribute information on said road segment from a transmission apparatus having the digital map (Ito: C 3, L 65-67);

another digital map including data representing the road segment, said data being different from the list of points (Ito: C 9, L 38-42; EN: Having not defined the term “different” in the claimed invention, and having not claimed what the applicant means by claiming that the “list of points” is “different” from the “data”, the examiner has asserted a definition of these terms and phrases. Based on this assertion, the examiner has found that Ito et al. anticipates the applicant’s claim “list of points” being “different”. This assertion is based on the fact that it would have been obvious to one of ordinary skill in the art that the data transmitted from one location is "different" from the data at a second location.);  
and

an identifying unit that performs matching of said points with said data to identify said road segment on the another digital map using coordinates information of the points and the attribute information included in the location information (Ito: C 19, L 66-67; C 20 L 1-12; Fig. 11).

Ito does not teach the use of event location information or point at the periphery of an event.

Myr teaches

The mapping of event location information (Myr: ¶ 0178; EN: Having not further defined the applicant's claimed "event location information" in the claimed invention, the examiner has found that the applicant's claimed "event location information" reads on the traffic accident (i.e. the "event") location information as taught by Myr.

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It would have been obvious to one of ordinary skill in the art at the time of invention to combine the vehicle guidance system of Myr and the vehicle navigation apparatus of Ito with the location determination method taught by Schipper for the purpose of mapping user locations using inconsistent location information (Schipper: C 5, L 10-20).

Regarding claim 17 and 18:

Ito teaches



(Previously presented): The transmission apparatus according to claim 12, wherein said attribute information includes at least one information item chosen from a group consisting of road type code, road number, toll highway code, number of traffic lanes, regulation information, road width, number of connecting links to a crossing node, and connection angle of each connecting link to a crossing node (Ito: C 9, L 19-25; Fig. 25).

### *Response to Arguments*

Applicant's arguments filed on August 12, 2008 have been fully considered and are moot. However, in light of the newly amended claims, a new grounds of rejection has been set forth above.

### *Conclusion*

#### Examiner's Opinion:

The examiner has considered the applicant's arguments in light of the claimed invention. Furthermore, the examiner respectfully reminds the applicant that **"during examination, the claims must be interpreted as broadly as their terms reasonably allow"**. (MPEP 2111.01 [R-5] I)

It is the goal of the Examiner to move the applicant's claimed invention towards allowability. However, as presently claimed, the applicant's claimed invention is substantially broad and is broad enough to read on the prior art of record. The examiner respectfully request that the applicant consider what the invention is, and where the line

between the prior art (cited by the examiner and/or known by the applicant) and the applicant's intended invention lay. This request is made so the examiner can help the applicant arrive at claim language that not only traverses the language taught in the presently pending and/or previously disclosed prior art, but also traverses concepts taught (or suggested) in prior art known by the examiner and/or applicant which has not been cited. Also, the examiner is more than willing to have an interview with applicant, but requests that the applicant disclose what he or she considers to be the most inventive portion of the claimed and/or disclosed invention.

- Regarding 101, the examiner takes the position that the applicant claimed invention while operating on road and location data, claims nothing to indicate that the identified location is observable in the real world.

Should the applicant choose to amend, the Examiner respectfully suggests that the applicant specifically indicate how the identified location is observable in the real world (i.e. via a user interface some form). (The previously cited suggestions are not a recitation of allowable subject matter, but are rather subject matter disclosed/claimed by the applicant which will help further distinguish the claimed invention from the prior art. Furthermore, any amendment will require further searching of the prior art.).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claims 1, 6, 12-13, and 16-21 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrian L. Kennedy whose telephone number is (571) 270-1505. The examiner can normally be reached on Mon -Fri 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Vincent can be reached on (571) 272-3687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/ALK/

/David R Vincent/  
Supervisory Patent Examiner,  
Art Unit 2129